

Applicants: Mark Ledebøer et al.
Application No.: 10/700,333

REMARKS

The Claim Amendments

Applicants have canceled claim 57.

Applicants reserve the right to pursue canceled subject matter in this application or in future continuing or divisional applications.

The Response

The Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claim 57 under 35 U.S.C. §112, first paragraph, because the Examiner, while acknowledging that the specification enables a method for inhibiting JAK activity in a standard biological assay, contends that the specification does not reasonably provide enablement for a method of inhibiting JAK activity in a biological sample generally for the purpose of blood transfusion, organ transplantation, etc.

Applicants disagree that claim 57 "reaches through" to the corresponding therapeutic method of any or all diseases, disorders or conditions. However, to expedite prosecution, applicants have canceled claim 57, thereby obviating this rejection.

The Rejection Under 35 U.S.C. §101

The Examiner states that the claimed invention lacks patentable utility because the Examiner states that the specification does not teach or suggest any utility of the instant compounds.¹

Applicants disagree that claim 57 lacks patentable utility because, as acknowledged by the Examiner, the specification enables a method for inhibiting JAK activity in a biological assay, which clearly has patentable utility. Further, as discussed above, applicants disagree that claim 57 is a "reach-through" claim. However, to expedite prosecution, applicants have canceled claim 57, thereby obviating this rejection.

¹ Applicants note that the Examiner has failed to provide which claims allegedly lack patentable utility, but surmise that the Examiner is referring to claim 57.

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The Double Patenting Rejections

The Examiner has provisionally rejected claims 1, 5-29, 31, 32, 34, 35, 37, 38 and 40-58 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5-22 and 24 of copending application 10/702,113 (hereafter “the ‘113 application”). The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of instant claims substantially overlap with claims 1, 5-22 and 24 of the ‘113 application.

The Examiner has provisionally rejected claims 1, 5-29, 31, 32, 34, 35, 37, 38 and 40-58 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-60 of copending application 10/639,784 (hereafter “the ‘784 application”). The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of instant claims substantially overlap with claims 1-60 of the ‘784 application.

Applicants provide herewith a terminal disclaimer over each of the ‘113 application and ‘784 application, thereby obviating these rejections.

Conclusion

Applicants request that the Examiner enter the above amendments, consider the accompanying arguments, and allow the claims to pass to issue. Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicants request that the Examiner contact the undersigned at his convenience.

Respectfully submitted,

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